

## REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed September 3, 2009. At the time of the Final Office Action, Claims 25-34 were pending in this Application and were rejected. Claim 25 has been amended to further define various features of Applicant's invention. Applicant respectfully requests reconsideration and favorable action in this case.

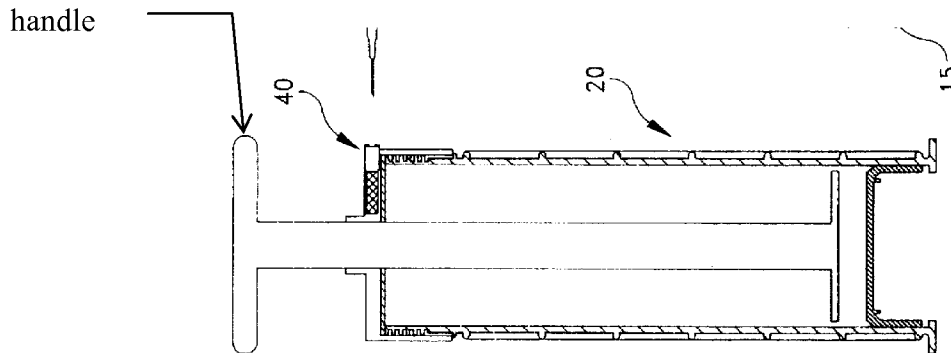
### **Rejections under 35 U.S.C. §102**

Claims 25, 26, 32, 33 and 34 stand rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,788,463 issued to Chan ("Chan"). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claim 25, Chan does not set forth that the control line is engaging a piston head and is adapted to advance the piston, as is now recited by amended claim 25. Chan describes a bone cement mixing container that is placed in vacuum by actuation of a pump connected to the container by a flexible tubing. Nowhere does Chan describe that any aspect of the flexible tubing engages a piston with the container, or that any aspect of the flexible tubing is adapted to advance a piston within the container. Rather, the flexible tube creates a vacuum that helps contain fumes from mixing bone cement within the container. Chan further states that once the vacuum in the container reaches a proper level for mixing bone cement, "the bone cement in container 20 is then mixed in ways well known in the art." See col. 10, ll. 42-45. As such, Chan does not teach that the vacuum-creating flexible tubing engages the piston head, or is

adapted to advance the piston in container 20. Presumably, the cement is mixed by manual advancement a handle (see below, Chan fig. 1 reproduced) connected to the piston connected to a handle disposed within the container, and not by remote actuation of the piston via the flexible tubing.



Because Chan does not set forth all of the elements of claim 25 as amended, Chan cannot anticipate amended claim 25. For at least these reasons, Applicant submits that amended claim 25 is in condition for allowance, and respectfully request withdrawal of the rejection.

Claims 26, 32, 33 and 34 depend directly or indirectly from claim 25. Applicant hereby repeats and incorporates the comments above with regard to amended claims 25. For at least these reasons, Applicant submits that claims 26, 32, 33 and 34 are in condition for allowance and respectfully request withdrawal of the rejection.

### **Rejections under 35 U.S.C. §103**

Claims 27-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chan. Applicant respectfully traverses and submits the cited art, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that

obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Claims 27-31 depend directly or indirectly from claim 25. Applicant hereby repeats and incorporates the comments made above with regard to amended claims 25. Specifically, Chan does not at least suggest a control line engaging a piston head and adapted to advance the piston, as is now recited by amended claim 25. The flexible tubing 45 described by Chan does not engage the piston of container 20, but rather is used only to create a vacuum in the container. Because Chan does not at least suggest all of the elements of amended claim 25, Chan cannot render obvious claims 27-31. For at least these reasons, Applicant submits that claims 27-31 are in condition for allowance, and respectfully request withdrawal of the rejection.

### **New Claims**

New claim 35 has been submitted to more completely describe the present invention.

### **Request for Continued Examination (RCE)**

Applicant encloses a Request for Continued Examination (RCE) Transmittal, and hereby authorized the Commissioner to charge \$810 to Deposit Account No. 50-0359 of ArthroCare Corporation.

### **Information Disclosure Statement**

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner’s review and consideration.

### CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$490 for the Two-Month Extension of Time and \$810 for the RCE to Deposit Account No. 50-0359 of ArthroCare Corporation. Applicant believes there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.358.5925.

Respectfully submitted  
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Date: 2/3/10

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Enclosure: 1) Information Disclosure Statement and PTO Form 1449, with copies of the references.